

REMARKS

I. Status of the Claims

Claims 49-105 are pending. Applicants have amended claims 49, 92, 98, and 99 to more explicitly recite that the composition is in the form of a structured nail polish. Support for this amendment, which is discussed in greater detail below, can be found throughout the application as filed, for example, on page 2, lines 22-28. Applicants have also corrected clerical errors in claim 105. No new matter has been added.

II. Compliance With 35 U.S.C. § 119(e)

The pending application claims priority to both French Application No. 01 00623, filed January 17, 2001, and U.S. Provisional Application No. 60/330,767 filed October 30, 2001. Although the Examiner acknowledged receipt of Applicants' claim for priority, she asserts that Applicants have failed to identify the provisional application in the written description of the pending non-provisional application. *Id.* The Examiner apparently believes an amendment is required to recite explicitly the reference to the claim for priority in the first sentence of the specification.

Applicants respectfully point out that, under 37 C.F.R. § 1.78(a)(5)(iii), no such amendment is required. Specifically, the rule states that the reference "must be included in either an application data sheet or the first sentence of the specification must contain or be amended to contain such reference in the first sentence following the title." 37 C.F.R. § 1.78(a)(5)(iii) (emphasis added). Here, Applicants made the claim for priority in the Information Data Sheet filed January 16, 2002, and thus do not need to amend the specification. Regardless, in an effort to advance prosecution, Applicants have amended the specification to recite the claim to priority.

III. Compliance With 37 C.F.R. § 1.98(b)

The Examiner states that listing references in the specification is not a proper Information Disclosure Statement ("IDS"). Office Action at 3. Applicants agree but respectfully note that every reference listed in the present specification was also listed in the IDS filed on July 18, 2002. Indeed, Applicants further note that the Examiner has already considered each reference, as evidenced by her initials on the 1449 form returned with the Office Action. Applicants, therefore, respectfully request clarification in the next official communication whether any reference listed in the specification (and thus the 1449 form) has in fact not been considered.

IV. Compliance With M.P.E.P. § 608.01(v)

The Examiner notes that the specification contains trademarks, including Uniclear[®], Versamid[®], and Onamid[®]. She alleges: "[They] should be capitalized wherever [they] appear[] and be accompanied by the generic terminology." Office Action at 4. According to the M.P.E.P., Applicants may use trademarks in the written description "if [they are] distinguished from common descriptive nouns by capitalization." M.P.E.P. § 608.01(v).

Although Applicants note that there is no rule or statute that requires the capitalization of trademarks, Applicants have amended the specification in an effort to advance prosecution. Indeed, Applicants have capitalized all registered trademarks throughout the specification, even those not specifically pointed out by the Examiner. No new matter has been added by these amendments.

V. **Rejection Under 35 U.S.C. § 102(b)**

The Examiner rejects claims 49-59, 61, 65-78, 82-84, 86-88, and 92-98 under 35 U.S.C. § 102(b) as anticipated by U.S. Pat. No. 4,655,836 to Drawert et al. ("Drawert"). Office Action at 4-5. Applicants respectfully request withdrawal of the rejection for the following reasons.

For a reference to anticipate the pending claims, it must teach, either expressly or inherently, each and every claimed element. M.P.E.P. § 2131; *PIN/NIP, Inc., v. Platte Chem. Co.*, 304 F.3d 1235, 1243 (Fed. Cir. 2002). In this case, Drawert does not teach, expressly or inherently, each and every claim limitation.

Drawert discloses "polyamide condensation products, comprising polymerized fatty acids and diprimary ether diamines, having antislip properties," and "nonslip coating compositions, particularly printing inks, containing the same." Drawert at col. 1, lines 4-8. Drawert does not disclose a structured nail polish, or any nail polish at all.

Presciently anticipating an argument that the claims' preamble would limit their scope, the Examiner alleges: "The preamble does not carry any patentable weight to claims as the claims are drawn to compositions." *Id.* at 5. Applicants submit, however, that the Federal Circuit has held relatively recently that a preamble may indeed limit composition claims. *Union Oil Co. v. Atl. Richfield Co.*, 208 F.3d 989, 995-6 (Fed. Cir. 2000) ("*Unocal*"). In *Unocal*, the claims recited either "[a]n unleaded gasoline suitable for combustion in an automotive engine" or "[a]n unleaded gasoline suitable for combustion in a spark ignition automotive engine." *Id.* at 995. Based on the language of the claims, the correct claim interpretation "excluded from claim scope a broader class of petroleum formulations such as aviation fuels or racing fuels." *Id.* Under the

rationale of *Unocal*, therefore, the Examiner incorrectly asserts that a preamble may never limit composition claims.

Regardless, solely in an effort to advance prosecution, Applicants have amended claims 49, 92, 98, and 99 as set forth above, i.e., to recite explicitly that the claimed at least one volatile organic solvent and claimed at least one first polymer are present "in a combined amount effective to provide a structured nail polish composition." Because the claims as amended are clearly limited in the body of the claim to structured nail polish compositions, Drawert, which does not teach or suggest nail polish compositions, cannot anticipate them or their dependent claims.

VI. Rejection Under 35 U.S.C. § 103

The Examiner rejects all pending claims 49-105 under 35 U.S.C. § 103 as obvious over U.K. Patent Application No. 2,196,978 to Plough ("Plough") in view of U.S. Patent No. 6,402,408 to Ferrari ("Ferrari"). Applicants disagree, because the Examiner has not yet set forth a proper prima facie case of obviousness with the requisite quantum of evidence. Moreover, Applicants believe that the present amendment further distinguishes the pending claims from Plough in view of Ferrari.

Applicants respectfully remind the Examiner that she has the burden of proving a prima facie case of obviousness. M.P.E.P. § 2142; *In re Rouffett*, 149 F.3d 1350, 1355 (Fed. Cir. 1999). To satisfy this burden, she must prove three elements: (1) some suggestion or motivation to modify a reference or combine reference teachings; (2) a reasonable expectation of success; and (3) that the prior art reference (or references when combined) teaches or suggests all the claim limitations. M.P.E.P. § 2143. In this case, the Examiner has failed to demonstrate at least the first and third elements.

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Furthermore, Applicants respectfully point out that the standards for proving a prima facie case of obviousness are high. Indeed, M.P.E.P. § 2142 states: "The examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness." *Cf. In re Fine*, 837 F.2d 1071, 1074 (Fed. Cir. 1988) (emphasis added). Thus, the Examiner must set forth "clear and particular" evidence of all elements of a prima facie case of obviousness. *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999). Otherwise, the record does not contain "substantial evidence," which is required to uphold a determination of prima facie obviousness. *In re Zurko*, 258 F.3d 1379, 1386 (Fed. Cir. 2001). As the Federal Circuit has recently reaffirmed, "[t]he factual inquiry whether to combine references must be thorough and searching" and "based on objective evidence in the record." *In re Lee*, 277 F.3d 1338, 1343 (Fed. Cir. 2002) (quotation omitted).

In this case, the Examiner asserts, without "clear and particular" evidentiary support, that a person of ordinary skill in the art would be motivated to add Ferrari's polymer to the compositions of Plough. In particular, the Examiner alleges that Plough discloses the presently claimed at least one volatile organic solvent, but she admits that the reference fails to disclose the at least one first polymer. Office Action at 7. To make up for this failure, the Examiner relies on the recitation of the at least one polymer in Ferrari. *Id.* Specifically, the Examiner alleges that it would have been obvious to combine the polymer of Ferrari with the compositions of Plough, "expecting beneficial effect to the nail." *Id.* The Examiner further states the motivation to combine comes from Ferrari's teaching that "the compositions provide glossy non-migrating film when applied on nails." *Id.* Such unsubstantiated assertions do not meet the threshold for

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prima facie obviousness; alleging obviousness based on supposed similar utility and applicability is simply insufficient.

Applicants respectfully submit that neither Plough nor Ferrari teaches or even remotely suggests a motivation to combine selected teachings taken out of context of each patent as a whole. M.P.E.P. § 2143.01; *cf. In re Rouffet*, 149 F.3d at 1357 (“rejecting patents solely by finding prior art corollaries for the claimed elements . . . would be an illogical and inappropriate process by which to determine patentability”) (quotation omitted). Plough, in particular, discloses a “cosmetic composition compris[ing] an amount of glyoxal sufficient to strengthen nails in admixture with a substantially non-aqueous nitrocellulose-based lacquer preparation.” Plough, Abstract. Indeed, the composition of Plough always contains glyoxal, which strengthens nails. *Cf. Plough* at 3-5.

The Federal Circuit has held a prior art reference must be considered in its entirety, and one may not “disregard[] disclosures in the references that diverge from and teach away from the invention at hand.” *W.L. Gore & Assocs., Inc., v. Garlock, Inc.*, 721 F.2d 1540, 1550 (Fed. Cir. 1983); *see also Bausch & Lomb, Inc., v. Barnes-Hind/Hydrocurve, Inc.*, 796 F.2d 443, 448 (Fed. Cir. 1986). Thus, the Examiner must consider the entire disclosure of Plough, including those portions requiring additional elements. *See In re Kotzab*, 217 F.3d 1365, 1370 (Fed. Cir. 2000) (“a rejection cannot be predicated on mere identification in [a prior art reference] of individual components of claimed limitations”). As noted above, Plough teaches “a cosmetic composition for strengthening nails comprising an amount of glyoxal effective for strengthening nails in a substantially non-aqueous conventional nitrocellulose-based nail lacquer preparation.”

Plough at 1, lines 44-47 (emphasis added). Here, the pending claims do not require glyoxal. And there is nothing in Plough, when understood as a whole, that would have suggested to a person of ordinary skill in the art to create a composition that does not require glyoxal.

Ferrari, furthermore, also does not supply the requisite motivation. It discloses "compositions for the care of, for treating and for making-up at least one keratinous material, in particular at least one human keratinous material, such as skin, including scalp, lips, eyelashes and eyebrows, comprising at least one liquid fatty phase gelled with at least one structuring polymer." Ferrari, col. 1, lines 6-10. But nowhere does Ferrari teach or suggest the combination of its disclosure with an element plucked and chosen from Plough.

Importantly, Applicants would like to emphasize that the Examiner's alleged motivation, i.e., "the compositions provide glossy non-migrating film when applied on nails," does not even make sense from a technical perspective. A nail polish composition, after application on the nails, forms a dry film and thus does not migrate. As understood by a person of ordinary skill in the art, migration would indicate a running of the composition, especially of the liquid fatty phase, into wrinkles and fine lines on the skin or lip. See Ferrari, col. 1, lines 32-35. Nail polish compositions, however, are not concerned with migration problems. Thus, there would be no motivation to modify a nail polish composition, such as the one taught by Plough, with the composition of Ferrari, which solves a problem wholly irrelevant to a nail polish composition.

Thus, it appears that the Examiner is combining one ingredient from each reference (i.e., a solvent from Plough and a polymer from Ferrari) and not looking at

each reference as a whole as required by the M.P.E.P. Again, the Federal Circuit has remarked that "[s]uch an approach would be an illogical and inappropriate process by which to determine patentability." *In re Rouffet*, 149 F.3d at 1357 (quotation omitted) (emphasis added).

Finally, the claims as amended explicitly require that the at least one volatile organic solvent and the at least one first polymer be present in an amount effective to provide a structured nail polish composition. Because a motivation to combine the references to achieve this claim element is not present in either reference, all claim limitations are not taught or suggested by the asserted references. M.P.E.P. § 2143.03. Applicants, therefore, request withdrawal of the rejection of all pending claims under 35 U.S.C. § 103(a) for this reason alone, as well as for all of the reasons set forth above.

VII. **Conclusion**

In view of the foregoing amendments and remarks, Applicants respectfully request the reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account No. 06-0916.

Respectfully submitted,

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APPENDIX TO AMENDMENT OF MARCH 27, 2003

Version with Markings to Show Changes Made

Amendments to the Specification:

On page 1, before line 1, please add the following paragraph:

This application claims the benefit of priority to French Application No. 01 00623,
filed January 17, 2001, and to U.S. Provisional Application No. 60/330,767, filed
October 30, 2001.

Please amend the three consecutive paragraphs beginning on page 12, line 4,
and ending on page 13, line 13, as follows:

Mention may be made, as examples of first polymers according to the invention,
of the commercial products sold by Arizona Chemical under the names [Uniclear®]
UNICLEAR 80 and [Uniclear®] UNICLEAR 100. They are sold respectively in the form of
an 80% (as active material) gel in a mineral oil and of a 100% (as active material) gel.
They have a softening point of 88 to 94°C. These commercial products are a blend of
copolymers of a C₃₆ diacid condensed with ethylenediamine, with a weight-average
molecular mass of approximately 6 000. The end ester groups result from esterification
of the remaining acid endings with cetyl alcohol, stearyl alcohol or their mixtures (also
known as cetearyl alcohol).

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Mention may also be made, as first polymer which can be used in the invention, of polyamide resins resulting from the condensation of an aliphatic dicarboxylic acid and of a diamine (including compounds having more than 2 carbonyl groups and 2 amine groups), the carbonyl and amine groups of adjacent individual units being condensed via an amide bond. These polyamides are in particular those sold under the [Versamid®] VERSAMID trademark by General Mills Inc. and Henkel Corp. ([Versamid®] VERSAMID 930, 744 or 1655) or by Olin Mathieson Chemical Corp. under the [Onamid®] ONAMID trademark, in particular [Onamid®] ONAMID S or C. These resins have a weight-average molecular mass ranging from 6 000 to 9 000. For further information on these polyamides, reference may be made to the documents US-A-3 645 705 and US-A-3 148 125. More especially, [Versamid®] VERSAMID 930 or 744 is used.

It is also possible to use the polyamides sold by Arizona Chemical under the [Uni-Rez®] UNI-REZ references (2658, 2931, 2970, 2621, 2613, 2624, 2665, 1554, 2623, 2662) and the product sold under the reference [Macromelt] MACROMELT 6212 by Henkel. For further information on these polyamides, reference may be made to the document US-A-5 500 209.

Please amend the paragraph on page 17, which begins with line 3 and ends with line 17, as follows:

Mention may be made, as volatile organic solvent which can be used in the invention, of volatile hydrocarbonaceous oils having from 4 to 16 carbon atoms and their

mixtures and in particular linear C6-C10 alkanes, such as n-hexane, n-heptane or n-octane, branched C8-C16 alkanes, such as C8-C16 isoalkanes (also known as isoparaffins), isododecane, isodecane, isohexadecane and, for example, the oils sold under the tradenames of [Isopars] ISOPARS or [PermethyIs] PERMETHYLS, esters having from 4 to 8 carbon atoms, such as ethyl acetate, n-propyl acetate, isobutyl acetate or n-butyl acetate, branched C8-C16 esters, such as isohexyl neopentanoate, and their mixtures. Preferably, the volatile organic solvent is chosen from volatile hydrocarbonaceous oils having from 4 to 10 carbon atoms and their mixtures.

Please amend the paragraph beginning on page 18, line 23, and ending on page 19, line 27, as follows:

In particular, the polar oils can be chosen from:

- hydrocarbonaceous vegetable oils with a high content of triglycerides composed of esters of fatty acids and of glycerol, the fatty acids of which can have various C₄ to C₂₄ chain lengths, it being possible for the chains to be linear or branched and saturated or unsaturated; these oils are in particular wheat germ, maize, sunflower, karite, castor, sweet almond, macadamia, apricot, soybean, cottonseed, alfalfa, poppy, pumpkinseed, sesame, cucumber, rapeseed, avocado, hazelnut, grape seed, blackcurrant seed, evening primrose, millet, barley, quinoa, olive, rye, safflower, candlenut, passionflower or musk rose oils; or triglycerides of caprylic/capric acids, such as those sold by Stearineries Dubois or those sold under the names [Miglyol] MIGLYOL 810, 812 and 818 by Dynamit Nobel;
- synthetic oils or synthetic esters of formula R₅COOR₆ in which R₅ represents the

residue of a linear or branched fatty acid comprising from 1 to 40 carbon atoms and R_6 represents a hydrocarbonaceous chain, in particular a branched hydrocarbonaceous chain, comprising from 1 to 40 carbon atoms, provided that $R_5 + R_6$ is ≥ 10 , such as, for example, purcellin oil (cetearyl octanoate), isononyl isononanoate, C_{12} to C_{15} alkyl benzoate, isopropyl myristate, 2-ethylhexyl palmitate, isostearate isostearate, or octanoates, decanoates or ricinoleates of alcohols or polyalcohols; hydroxylated esters, such as isostearyl lactate or diisostearyl malate; and pentaerythritol esters;

- synthetic ethers having from 10 to 40 carbon atoms;
- C_8 to C_{26} fatty alcohols, such as oleyl alcohol;
- their mixtures.

Please amend the paragraph beginning on page 23, line 23, and ending on page 24, line 6, as follows:

Use may in particular be made, as film-forming polymer, of nitrocellulose RS 1/8 sec.; RS 1/4 sec.; 1/2 sec.; RS 5 sec.; RS 15 sec.; RS 35 sec.; RS 75 sec.; RS 150 sec.; AS 1/4 sec.; AS 1/2 sec.; SS 1/4 sec.; SS 1/2 sec.; SS 5 sec.; sold in particular by Hercules; toluenesulfonamide-formaldehyde resin "[Ketjentflex] KETJENFLEX MS80" from Akzo or "Santolite MHP" or "Santolite MS 80" from Faconnier or "Resimpol 80" from Pan Americana, alkyd resin "[Beckosol] BECKOSOL ODE 230-70-E" from Dainippon, acrylic resin "[Acryloid] ACRYLOID B66" from Röhm & Haas, or polyurethane resin "[Trixene] TRIXENE PR 4127" from Baxenden.

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Amendments to the Claims:

49. (Amended) A structured nail polish composition comprising:

at least one liquid organic phase comprising at least one volatile organic solvent, the liquid organic phase being structured by at least one first polymer having a weight-average molecular weight of less than or equal to 100,000 and comprising:

a) a polymer backbone comprising hydrocarbon-based repeating units, said units comprising at least one hetero atom in said backbone, and

b) at least one fatty chain containing from 6 to 120 carbon atoms and chosen from at least one pendent fatty chain and at least one terminal fatty chain, wherein the at least one fatty chain is linked to the hydrocarbon-based units and is optionally functionalized,

wherein said at least one volatile organic solvent and said at least one first polymer are present in the nail polish composition in a combined amount effective to give a structured nail polish composition.

92. (Amended) A stick nail polish composition comprising:

a liquid organic phase comprising at least one volatile organic solvent and at least one first polymer with a weight-average molecular weight of less than or equal to 100,000 comprising:

a) a polymer backbone comprising hydrocarbon-based repeating units, said units comprising at least one hetero atom in said backbone, and

b) at least one fatty chain containing from 6 to 120 carbon atoms and chosen from at least one pendent fatty chain and at least one terminal fatty chain,

wherein the at least one fatty chain is linked to the hydrocarbon-based units and is optionally functionalized,

wherein said at least one volatile organic solvent and said at least one first polymer are present in the stick nail polish composition in a combined amount effective to give a structured stick nail polish composition.

98. (Amended) A cosmetic process for making up or nontherapeutically treating the nails of human beings, comprising:

applying to the nails of human beings an effective amount of a composition comprising:

a liquid organic phase comprising at least one volatile organic solvent and at least one first polymer with a weight-average molecular weight of less than or equal to 100,000 comprising:

a) a polymer backbone comprising hydrocarbon-based repeating units, said units comprising at least one hetero atom in said backbone, and

b) at least one fatty chain containing from 6 to 120 carbon atoms and chosen from at least one pendent fatty chain and at least one terminal fatty chain, wherein the at least one fatty chain is linked to the hydrocarbon-based units and is optionally functionalized,

wherein said at least one volatile organic solvent and said at least one first polymer are present in the composition in a combined amount effective to give a structured composition.

99. (Amended) A method of producing a nail polish composition in the form of stick, comprising:

a liquid organic phase comprising at least one volatile organic solvent and at least one first polymer with a weight-average molecular weight of less than or equal to 100,000 comprising:

a) a polymer backbone comprising hydrocarbon-based repeating units, said units comprising at least one hetero atom in said backbone, and

b) at least one fatty chain containing from 6 to 120 carbon atoms and chosen from at least one pendent fatty chain and at least one terminal fatty chain, wherein the at least one fatty chain is linked to the hydrocarbon-based units and is optionally functionalized,

wherein said at least one volatile organic solvent and said at least one first polymer are present in the nail polish composition in a combined amount effective to give a structured nail polish composition.

105. (Amended) The [composition] method according to claim 99, wherein the composition [omprises] comprises at least one second film-forming polymer.